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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,277	06/15/2001	Markus Lautenbacher	P01,0200	7143
26371	7590	10/02/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			NAWAZ, ASAD M	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,277

Applicant(s)

LAUTENBACHER, MARKUS

Examiner

Asad M. Nawaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20,24-26,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20,24-26,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment received on 6/23/06. Claims 16 and 24 have been amended. Claims 30-31 have been newly added. No other claims have been added, amended, or canceled. Accordingly, claims 16-20, 24-26, and 30-31 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-20, 24-26, and 30-31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the added limitation of interworking programs with applications on at least one other terminal is not founded in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16-20 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Devarakonda et al (US Patent No. 6,757,729).

As to claim 16, Devarakonda teaches In an IP-based network, a system comprising: at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis; (Abstract; Fig 1; col 2, 28-40; col3, 50-56; col 4, 1-5 and 38-40)

And at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to network with the application programs on at least one other terminal of the network for realizing user services. (Fig 1; col 4, 43-44; col 6, 4-8)

As to claim 17, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to basic user services. (col 3, 50-56; col 4, 51-67; col 5, 10-24)

As to claim 18, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to Internet Telephony service.(col 4, 11-15)

As to claim 19, Devarakonda teaches the system of claim 18, wherein said user specific subscribable services can be user configured via said at least one terminal.(Fig. 1; Fig. 4; col 3, 40-49)

As to claim 20, Devarakonda teaches the system of claim 19, wherein said server includes a Java system, and said at least one terminal supports downloading of said applications programs.(col 2, 20-23 and 49-61; col 3, 3-10; col 4, 44-47)

Claims 24 presents no new limitations above claim 16 above and is thus rejected under similar rationale.

As to claim 25, Devarakonda teaches the terminal of claim 24, wherein said application execution component is implemented as a virtual machine. (abstract)

As to claim 26, Devarakonda teaches the terminal of claim 25 wherein said user subscribable services can be configured via said client component. (col 3, lines 39-61)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being anticipated by Devarakonda et al (US Patent No. 6,757,729) further in view of Brocker et al (USPN: 5,365,606).

As to claim 30, Devarakonda teaches the system of claim 16 however, Devarakonda does not explicitly indicate that the application execution environment is being ported to the terminal only once.

Brocker et al teaches a virtual software machine that runs multiple program modules in a single address space of a target computer. Thus the application execution environment is ported only once to the terminal (col 1, lines 62 to col 2, line 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Brocker into those of Devarakonda to make the system to make the system more efficient. Such a system would reduce operating system resource consumption and increase transaction time (col 1, lines 56-57).

Claims 31 presents no new limitations above claim 30 above and is thus rejected under similar rationale.

Response to Arguments

8. Applicant's arguments filed have been fully considered but they are not persuasive. In substance the applicant argues that A) Devarakonda teaches services executed by the network and B) there is no motivation to combine Devarakonda and Brocker as it would result in redundancy.

In response to A), the applicant is directed to col 1, lines 45-54 in which the applicant claims that Devorakonda teaches services executed by the network. This section in no way teaches that the services are executed by the network. Rather it points to the fact that the actions are taken a network computer, alternately termed the client. Furthermore, the VEM environment is essentially the same as the AXE of the instant application. The aim of both environments is to allow platform independent execution.

In response to B), the rejection under 103(a) applied to the independent claims has been withdrawn. However, it should be noted that when combining references to formulate a rejection, the overlapping teachings of each reference should not be construed as being repetitive or redundant. Rather, it should show that the two references are easily combinable since they have common operations and components.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AMN


Philip Tran
PRIMARY EXAMINER